

### **REMARKS**

Claims 19 and 24 are pending and have been amended. Claim 18 has been canceled.

The claims have been amended for clarity and to put them in a better position for allowance or appeal. Support for the amendments can be found throughout the specification, and as described below.

Applicants respectfully request the indulgence of the Examiner in permitting entry of the amendments made after final. It is believed these amendments are directly responsive to the outstanding rejections under 35 U.S.C. § 112, second paragraph, and to the first paragraph rejection as well.

Applicants appreciate the withdrawal of a large number of rejections previously made.

No new matter has been added by way of this amendment.

### **Claim Objection**

The objection with regard to misspelling in claim 19 is now moot in light of the removal of the misspelled word from the claim.

### **Rejection of Claims Under 35 U.S.C. § 112, Second Paragraph**

Claims 19 and 24 were rejected under 35 U.S.C. § 112, second paragraph, as being indefinite, on the allegation that the terms “erythromycin derivative” and “6-dEB derivative” are confusing as to their metes and bounds. These terms no longer appear in the claims. The Examiner

has kindly acknowledged that the specification is adequate with respect to compounds 1, 6 and 7 in Figure 3 as representing unglycosylated forms of 6-dEB and 9, 10 and 11 of that Figure as representing their glycosylated counterparts. As shown in Figure 1, the substituent at position 13 in the natural 6-dEB is ethyl; unnatural forms (thus characterized in Example 4) are represented as formulas 6 and 7 in Figure 3. Thus, claim 19 is a generalization of this set of illustrative compounds. Claim 24 is limited to these compounds specifically. Because the genus of unnatural substituents at position 13 was explicitly recognized on page 8, at line 5, it is believed that the claims as presently worded do not represent new matter. Entry of the amendments to the claims is respectfully requested.

Applicants have inserted the full name of 6-deoxyerythronolide B into the claims to define “6-dEB” at the suggestion of the Office, although it is believed that 6-dEB is as recognizable to the skilled practitioner.

Claims 19 and 24 stand rejected based on the alleged lack of clarity of the phrase “6-dEB derivative produced in a recombinant organism other than *Saccharopolyspora erythraea*”. The unnecessary phrase “derivative produced in a recombinant organism other than *S. erythraea*” has been deleted from claim 19.

It is believed that the amendments to the claims dispose of the rejections under 35 U.S.C. § 112, second paragraph.

#### **Rejection of Claims Under 35 U.S.C. § 112, First Paragraph**

Claims 19 and 24 stand rejected under 35 U.S.C. § 112, first paragraph, new matter, as failing to comply with the written description requirement.

The Office asserts that the application as filed does not support using any 6-dEB derivative in the adding step if it has a scope broader than defined in Figure 3, or making any erythromycin derivative in the culturing step provided that the erythromycin derivative has a scope broader than compounds 9, 10 and 11, and that the phrase referred to above regarding “recombinant organisms” is broader than the specification.

As to the last of these, that phrase is deleted as unnecessary. With regard to the first two criticisms, it is respectfully submitted that although the derivatives in Figure 3 are illustrative, the specification demonstrates glycosylation of 6-dEB itself (*i.e.*, with ethyl in the 13 position) as well as “unnatural” forms which have other substituents in the 13 position as represented and illustrated by the compounds in Figure 3. It is believed that a skilled artisan reading the specification would understand that 6-dEB forms that lack glycosylation and which have unnatural substituents at position 13 would be included within the scope of the invention.

Accordingly, applicants respectfully request that the rejection under 35 U.S.C. § 112, first paragraph, written description, be withdrawn and the two pending claims, claims 19 and 24, be passed to issue.

If minor issues remain that could be resolved in a telephone discussion, a telephone call to the undersigned is respectfully requested.

In the unlikely event that the transmittal letter is separated from this document and the Patent Office determines that an extension and/or other relief is required, applicants petition for any required relief including extensions of time and authorize the Assistant Commissioner to charge the cost of such petitions and/or other fees due in connection with the filing of this document to **Deposit Account No. 03-1952** referencing docket No. 300622000212.

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Respectfully submitted,

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